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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,154	07/03/2003	Anna-Carin Elfstrom	018798-171	4120

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EXAMINER	
HAND, MELANIE JO	
ART UNIT	**PAPER NUMBER**
3761	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/612,154	ELFSTROM ET AL.	
	Examiner	Art Unit	
	Melanie J. Hand	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 June 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments, see Remarks, filed June 6, 2006, with respect to the rejection(s) of claim(s) 1, 2, 6-14, 16, 18-20 and 23-28 under 35 U.S.C. 102 and the rejection of claims 3-5, 15, 17, 21, 22 under 35 U.S.C. 103 regarding only the deficiencies of Rooyakkers under 35 U.S.C. 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a different interpretation of a previously applied reference.

Applicant's arguments with respect to the rejection of claims 3-5 and 28 over Rooyakkers in view of Wilson have been fully considered but they are not persuasive. A rejection under 35 U.S.C. 103 is made in view of the structural limitations of the combined teaching of Rooyakkers and Wilson. Wilson teaches a sport short, therefore the combined teaching Rooyakkers and Wilson as a whole has a pants shape. The fact that Examiner cites a teaching of Wilson regarding only the waistband is immaterial, as Wilson teaches a motivation for combining the instant invention with the prior art of Rooyakkers, thus rendering claims 3-5 and 28 unpatentable.

Drawings

The drawings were received on June 6, 2006. These drawings are acceptable.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 6-14, 16-20, and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rooyakkers ('012).

With respect to **Claims 1,26:** Rooyakkers teaches an absorbent genitalia pouch 40 that comprises a front section, crotch section and rear section. Device 40 is comprised of a laminate 190 of a liquid-impermeable material 196 on the exterior surface facing away from the user, an absorbent material 194 and a liquid-permeable material 192 facing the inside of the pouch that is folded into the configuration seen in Figs. 12, 15 and 18, wherein the absorbent layer tapers toward the bottom of device 40 from the front section of said briefs toward said crotch section to form a narrower end section. (Col. 3, lines 26-30) As can best be seen in Figs. 6,7, said narrower end section terminates below the penis of the user. The pad material 190 liquid-impermeable and liquid-permeable layers of sheet 190 are sealed together beyond the edge of the absorbent layer. The absorbent material in device 40 absorbs any urine emitted from the penis of the user thus preventing leakage toward the crotch section of said briefs.

Rooyakkers does not explicitly teach a liquid barrier applied at the narrower end of said pouch. However it is known in the art of male external catheters to provide a seal in contact with a user's penis to prevent backflow or leakage, therefore since the pouch of Rooyakkers also collects urine, it would be obvious to one of ordinary skill in the art to provide a seal or barrier on the liquid permeable layer of the pouch of Rooyakkers so as to further ensure protection against leakage.

With respect to **Claims 2,27**: Rooyakkers teaches that the pouch 40 is adapted to be worn in briefs 44. Device 40 is equipped with adhesive strips on an outer side of liquid-impermeable

layer 196 to allow attachment to the inside surface of said briefs to hold pouch 40 in place. (Col. 6, lines 54-61)

With respect to **Claim 6:** Because Rooyakkers teaches that the entire device 40 is formed from a laminate 190 that includes absorbent material, the absorbent material that forms the bottom of said device is also contained within said liquid-impermeable and liquid-permeable sheets.

With respect to **Claims 7,8:** As can best be seen in Figs. 12, 15 and 18, the shape of device 40 has a convex configuration at its narrower end, and because of the manner in which the device is formed (i.e. from said laminate as a unitary piece folded such that there are surfaces of said laminate perpendicular to other surfaces of said laminate), portions of device 40 will cross the absorbent material on the side of device 40 that is adjacent the skin of the user, and also thus extends laterally from said side adjacent the skin of the user. With respect to Claim 8, the absorbent material in the portion of device 40 that faces away from the user spans the entire device in the transverse direction, as is best seen in Figs. 12, 15 and 18.

With respect to **Claims 9-11:** Rooyakkers teaches a volume for device 40 of 275-400 cm^3 and an equilateral triangle-shaped opening that is 10 cm on each side, therefore the depth of said pouch is between 12-18 inches. (Col. 6, lines 26-33) Rooyakkers teaches a desirable cross-sectional area for a point 5-6.5 cm down the back wall to ensure that the slope is not too severe as to limit proper placement of the penis of the user (Col. 6, lines 46,47), therefore Examiner is considering the portion that is between 6.5 cm and the bottom as the effective absorbent end portion that is substantially identical to the claimed invention and thus the height of the effective absorbent end portion has a height in the range of 65 – 180 mm.

With respect to **Claim 12:** Rooyakkers teaches that device 40 maintains its position when in operation within said briefs 44 (Col. 6, lines 54-56) therefore inner sections of device 40 will remain raised away from the inner surface of said briefs.

With respect to **Claim 13,14:** As can best be seen in Figs. 11 and 12, a sheet of material 190 is folded into a roll with a triangular cross section and then folded once more to form the convex narrow end.

With respect to **Claim 15:** As can best be seen from Fig. 12, the resulting narrow end portion has a "V" shape.

With respect to **Claim 16:** As can best be seen in Fig. 15, Rooyakkers teaches a "U-shaped" narrow end, where the base of the "U" resides in the crotch section when worn with an undergarment.

With respect to **Claim 18,20:** Rooyakkers teaches that material 190 is a composite containing a polyethylene-polyvinyl acetate foam sheet that is liquid-impermeable. (Col. 7, lines 2-4)

With respect to **Claim 19:** Rooyakkers teaches that device 40 is formed by folding laminate 190 into a pouch shape thermally molded and then applied to an undergarment 44. (Figs. 6,12, 15 18)

With respect to **Claim 23:** As can best be seen in Fig. 6, Rooyakkers teaches that device 40 after being formed from sheet 190 and then thermally molded maintains its raised configuration without external aid in briefs 44, therefore device 40 possesses an inherent stiffness that is sufficient to hold it in the folded configuration.

With respect to **Claims 24,25:** Rooyakkers teaches that the absorbent material is comprised of wood fibers with superabsorbent gel material added therein. (Col. 6, lines 1-3) Rooyakkers teaches that the foam sheet 190 is molded into place and then is lined with absorbent coform that is an airform mixture of wood fibers and polyethylene. (Col. 5, lines 43-45)

With respect to **Claims 29,30,32,33:** Rooyakkers does not explicitly teach a liquid-impermeable liquid barrier applied at the narrower end of said pouch. However it is known in the art of male external catheters to provide a seal in contact with a user's penis to prevent backflow or leakage, therefore since the pouch of Rooyakkers also collects urine, it would be obvious to one of ordinary skill in the art to provide a seal or barrier on the liquid permeable layer of the pouch of Rooyakkers so as to further ensure protection against leakage.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3-5 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rooyakkers ('012) in view of Wilson et al (U.S. Patent No. 6,023,789).

With respect to **Claims 3,4,5,28,31:** Rooyakkers teaches tight-fitting briefs 44 for use in conjunction with device 40 but does not explicitly teach that said briefs have an elastic waistband. Wilson teaches a sports short 10 made of Lycra™ ('789, Col. 4, lines 19-21) material having a genital protector comprising an elastic waistband. Wilson teaches that said elastic waistbands allow accommodation of a variety of waist sizes ('789, Col. 3, lines 8-10), therefore it would be obvious to one of ordinary skill in the art to modify the briefs taught by Rooyakkers to contain an elastic waistband as taught by Wilson. With respect to claim 4, Wilson also teaches that the body portion of the shorts, including the crotch portion, is formed from elastic material ('789, Col. 4, lines 19-21) that is capable of being pulled down and subsequently returned to an initial position against the wearer via said elastic waistband and elastic material. Wilson teaches that the elastic material applies a compressive force for added protection and moisture wicking (Col. 3, lines 1-5), therefore it would be obvious to one of ordinary skill in the art to modify the briefs taught by Rooyakkers to be comprised of elastic material that is not only tight fitting (as taught by Rooyakkers) but able to be pulled and deformed for easy removal as taught by Wilson.

With respect to **Claim 17:** Rooyakers does not teach a particular folding angle for the U-shaped narrow end. As seen in Figs. 9 and 13-15, the angle is clearly less than 90 degrees. Applicant does not set forth a criticality for the measurement of the angle so as to encompass the alternate teaching of a "V-shaped" barrier, therefore Examiner is considering the limitation that the angle be exactly 45 degrees or less than 45 degrees to be optimizations of the angle measurement and are therefore unpatentable over the prior art of Rooyakkers. It has been held that where general conditions of claim are disclosed in prior art, it is not inventive to discover optimum or workable ranges by routine experimentation. See *In re Aller, Lacey and Hall (105*

USPQ 233, CCPA, 1955). It would be obvious to one of ordinary skill in the art to vary the folding angle to be equal to or less than 45 degrees so as to achieve different varieties of a U-shaped barrier, as any U-shaped barrier would ensure proper support and function of the device of Rooyakkers.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rooyakkers ('012) in view of Runeman (U.S. Patent No. 5,486,168).

With respect to **Claims 21,22:** Rooyakkers does not teach the use of elastic to hold device 40 in the raised state. With respect to claim 22, Rooyakkers thus also does not teach elastic thread. Runeman teaches a liquid barrier that is maintained in a substantially identical shape via the use of elastic elements 9. ('168, Col. 3, lines 18,19) The device of Runeman is also capable of being placed in a freestanding manner within an undergarment ('168, Col. 2, lines 21-34) as the device of Rooyakkers is capable of accomplishing as well, therefore Examiner is considering the use of elastic elements taught by Runeman to be simply an alternate method to the use of thermal molding as taught by Rooyakkers, thus it would be obvious to one of ordinary skill in the art to attach elastic threads to the device of Rooyakkers in lieu of thermal molding to allow said device to be placed in a freestanding manner, not requiring any additional support means and is thus capable of and suited for use with an undergarment.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie J. Hand whose telephone number is 571-272-6464. The examiner can normally be reached on Mon-Thurs 8:00-5:30, alternate Fridays 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie J Hand
Examiner
Art Unit 3761

MJH

TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER